

ESTTA Tracking number: **ESTTA543807**

Filing date: **06/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206546
Party	Defendant Mexcor, Inc.
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Date	06/19/2013
Attachments	Answer_&_Counterclaim_Tennessee_Crown.pdf(93803 bytes)

Registration Subject to the filing

Registration No	4151987	Registration date	05/29/2012
Registrant	The R.S. Lipman Company 407 Great Circle Rd Nashville, TN 37228 UNITED STATES		

Goods/Services Subject to the filing

Class 032. First Use: 2011/06/07 First Use In Commerce: 2011/06/07 All goods and services in the class are requested, namely: Beer

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The R.S. Lipman Company,

Opposer,

v.

Mexcor, Inc.,

Applicant.

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Opposition No. 91206546

ANSWER AND COUNTERCLAIM

Applicant Mexcor, Inc. (“Applicant”) files this Answer and Counterclaim in response to Opposer’s Notice of Opposition.

I. ANSWER

Applicant Mexcor, Inc. (“Applicant”) responds to the correspondingly-numbered paragraphs of the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1 of the Notice of Opposition and therefore denies those allegations.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 2 and therefore denies those allegations.

3. Applicant admits the allegations in Paragraph 3.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 4 and therefore denies those allegations.

5. Applicant admits that the word TENNESSEE in both marks is identical but otherwise denies the allegations of Paragraph 5.

6. Applicant is without knowledge or information sufficient to form a belief as to the Opposer's expenditure of resources to promote and advertise its marks and therefore Applicant denies those allegations. It denies the remaining allegations in Paragraph 6.

7. Applicant admits it applied for the TENNESSEE CROWN mark based on an intent to use but otherwise denies the allegations contained in Paragraph 7.

8. Applicant admits that it applied for the TENNESSEE CROWN mark on July 25, 2011 but is without knowledge or information sufficient to form a belief as to the remaining allegations contained in paragraph 8 and therefore denies them.

9. Applicant admits that its product will not originate in the state of Tennessee but otherwise denies the allegations in Paragraph 9.

10. Applicant admits that the North American Free Trade Agreement defines "Tennessee Whiskey" as a type of "whiskey" authorized to be produced only in Tennessee but otherwise denies the allegations contained in Paragraph 10.

11. Applicant admits the allegations contained in Paragraph 11.

12. Applicant admits the allegations contained in Paragraph 12.

13. Applicant denies the allegations contained in Paragraph 13.

WHEREFORE, Applicant respectfully requests that the Notice of Opposition be in all respects dismissed and that the registration sought by Applicant be allowed.

II. COUNTERCLAIM

Applicant/Counterclaim-Petitioner Mexcor, Inc. ("Mexcor") files this Counterclaim against Opposer/Counter-Respondent The R.S. Lipman Company ("Lipman"), alleging that it

has been and will continue to be damaged by Registration No. 4,151,987 for the mark TENNESSEE for beer, purportedly owned by Lipman. As grounds for cancellation under the provisions of 15 U.S.C. § 1064(3), Mexcor shows the following:

1. Mexcor is a Texas corporation having a place of business at 8950 Railwood Dr Houston, TX 77078 (“Mexcor”).

2. Mexcor markets, sells, and distributes alcoholic beverages, including a brand of whisky known as TENNESSEE CROWN CLUB.

3. To the best of Mexcor’s knowledge, Lipman is a Tennessee corporation with its principal place of business at 411 Great Circle Rd., Nashville, TN 27228.

4. Lipman has obtained registration No. 4,151,987 on the Supplemental Registration for the design mark TENNESSEE for beer.

5. On July 25, 2011, Mexcor applied for registration of the mark TENNESSEE CROWN for “whiskey,” for which the United States Patent & Trademark Office issued serial number 85379607. On August 14, 2012, Lipman filed its Notice of Opposition to Mexcor’s application, claiming that Mexcor’s TENNESSEE CROWN CLUB mark for whisky is likely to cause confusion with its TENNESSEE trademark for beer. Negotiations between the parties have yet to resolve the dispute.

6. The term TENNESSEE is the name of a U.S. state. It has been and is widely used in connection with hundreds if not thousands of products, including alcoholic beverages, that identify with the state or invoke its qualities. That the term is merely descriptive is demonstrated by Lipman’s failure to obtain registration of it on the Principal Register.

7. Lipton’s registration should be cancelled because it is generic and because Lipton’s assertions of rights to the use of the word “TENNESSEE”—even in connection with

dissimilar products—unfairly restricts Mexcor from marketing its product. See 15 U.S.C. §§ 1064(3), 1068.

WHEREFORE, Mexcor, Inc. prays that Registration No. 4,151,987 be cancelled pursuant to 15 U.S.C. § 1064(3) because the TENNESSEE mark is generic.

Dated: June 19, 2013.

Respectfully submitted,

/John A. Tang/

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**ATTORNEYS FOR APPLICANT/
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Certificate of Service

This is to certify that a true and correct copy of the foregoing document was served upon all counsel of record via email and U.S. Mail in accordance with the Rules of the Trademark Trial and Appeal Board this 19th day of June, 2013 to:

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